

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Non-Fee Amendment, Director of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 8, 2004

Signature: Lynn L. Janulis  
(Lynn L. Janulis)

ZFW. AP/1645



PATENT APPLICATION  
Attorney Docket No: 28341/6227.NCP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
David E. Lowery et al.

Application No.: 09/545,199

Filed: April 6, 2000

Art Unit: 1645

For: ANTI-BACTERIAL VACCINE  
COMPOSITIONS

Examiner: V. Portner

Director of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION  
PURSUANT TO 37 C.F.R. § 1.181**

Dear Sir/Madam:

This is a petition to withdraw the premature final rejection stated in the Office action mailed April 8, 2004. This petition is timely filed within two months of the mailing of the final Office action.

## **Statement of Facts**

The Office action mailed April 8, 2004 (attached as Appendix A) is a final action that is responsive to the amendment mailed on December 15, 2003 (attached as Appendix B). In the pending Office action, the Examiner rejected claim 7 under 35 U.S.C. § 102(b) as being anticipated by Gwinn et al. (*J. Bacteriol.* 179:7315-7320, 1997). There was no previous prior art rejection based on Gwinn, which was disclosed by the Applicants in an information disclosure statement on February 8, 2001 as reference C39. The amendment mailed on December 15, 2003 was submitted in response to a non-final Office action mailed June 13, 2003 (attached as Appendix C). In the non-final action, the Examiner rejected claims 7-24 and 31-33 under 35 U.S.C. § 112, first and second paragraphs.

The amendment to claim 7 in the amendment mailed on December 15, 2003 is set out below.

7. (Previously amended) An attenuated *Pasteurellaceae* bacteria comprising a mutation in the atpG protein coding region of an atpG gene as set forth in SEQ ID NO: 3 or a species homolog thereof, said mutation resulting in decreased atpG biological activity, wherein the decreased atpG biological activity attenuates the *Pasteurellaceae* bacteria.

The amendment to claim 7 was stylistic and it was made merely to address a rejection of dependent claims 8-12, 14-18, and 21-24 under 35 U.S.C. § 112, second paragraph, on the ground that these claims lacked antecedent basis (in claim 7) for the phrase "atpG gene." The amendment did not substantially change the scope of the claims.

Upon receipt of the final Office Action, the Applicants telephoned the Examiner on April 16, 2004 and May 6, 2004 requesting reconsideration of the finality of the rejection. The Examiner reaffirmed her position that the finality of the rejection was proper. The Examiner emailed correspondence on May 24, 2004 (attached as Appendix D) asserting that amendment of claim 7 necessitated the new grounds for rejection set forth in the final rejection alleging that the combination of amended claim limitations submitted in the amendment broaden claim 7, thus necessitating new grounds of rejection. Further, the Examiner asserted that the amendment of claim 7, reciting the combination of the term

"gene" together with the phrase "or a species homolog thereof," reads on mutant strains of bacteria which evidence genetic mutations outside the coding region for atpG, and includes mutations within the atp operon, in promoters, control sequences and homologs of atpG, which would include atpA, a species homolog gene within the atpG gene/operon of the claimed family of bacteria. The Examiner also indicated that she will be mailing an Interview Summary, which has not yet been received by the Applicants.

### **Finality Should Be Withdrawn**

The grounds for finality are that the second or any subsequent action on the merits shall be final, except where the "examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." See MPEP § 706.07(a).

The Examiner asserted that the amendment of claim 7, reciting the combination of the term "gene" together with the phrase "or a species homolog thereof," reads on mutant strains of bacteria which evidence genetic mutations outside the coding region for atpG, and includes mutations within the atp operon, in promoters, control sequences and homologs of atpG, which would include atpA, a species homolog gene within the atpG gene/operon of the claimed family of bacteria.

However, the Applicants contend that the anticipation rejection of claim 7 is a new ground for rejection that was not necessitated by the Applicants' amendment. In the amendment mailed on December 15, 2003, Claim 7 was amended **from** "*a mutation in the atpG protein coding region set forth in SEQ ID NO: 3*" **to** "*a mutation in the protein coding region of an atpG gene as set forth in SEQ ID NO: 3*" in order to provide antecedent basis for the term "atpG gene" in the dependent claims. The amendment to claim 7 was stylistic and it was made merely to address a rejection of dependent claims 8-12, 14-18, and 21-24 under 35 U.S.C. § 112, second paragraph, on the ground that these claims lacked antecedent basis (in claim 7) for the phrase "atpG gene." The addition of the word "gene" did not substantially change the claim to warrant a new rejection under 35 U.S.C. § 102(b). Furthermore, the amendment did not add or remove a limitation that materially affected or changed the scope of claim 7. The mutation was and still is defined as being "in the protein coding region" of SEQ ID NO: 3. Moreover, the "species homolog" aspect of claim 7 was in the claim prior to amendment and, thus, is not a limitation introduced via amendment.

Furthermore, the word "gene" was already present in dependent claims 8-12 and 14-24, and it was present in original claim 7 as filed. Thus, original claim 7, by implication, included embodiments relating to a gene. If the dependent claims used the word "gene" and the Examiner thought the word "gene" was a broadening term, then the Examiner should have rejected the dependent claims as well. However, the dependent claims were not rejected on this basis and accordingly, the simple addition of the word "gene" to claim 7 for antecedent basis purposes in the amendment did not warrant a new rejection.

Regardless of the merit of rejection under 35 U.S.C. § 102(b), the Applicants contend that the subject matter of claim 7 was unchanged by the amendment and Gwinn was not newly disclosed. Therefore, if the Examiner perceived Gwinn to have anticipated claim 7, the rejection of claim 7 in light of Gwinn should have been made in a previous Office action. For all of the foregoing reasons, the finality of the rejection is improper.

### **CONCLUSION**

In view of the remarks made herein, the Applicants respectfully submit that the finality of the Office action dated April 8, 2004 be withdrawn in light of the new ground of rejection of claim 7.

The Applicants believe no fee is due with this petition. The Director is hereby authorized to charge any fee due with this petition to our Deposit Account No. 13-2855, under Order No. 28341/6227.NCP. A copy of this paper is enclosed.

Should the Director have any questions regarding this matter, he is welcomed to contact the undersigned at the telephone number below.

Dated: June 8, 2004

Respectfully submitted,

By   
Lynn L. Janulis

Registration No.: 53,066  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Agents for Applicants